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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,667	09/06/2000	Karen L. Briegs	ID01065Q	8973
24265	7590	02/06/2004	EXAMINER	
SCHERING-PLOUGH CORPORATION PATENT DEPARTMENT (K-6-1, 1990) 2000 GALLOPING HILL ROAD KENILWORTH, NJ 07033-0530			PASS, NATALIE	
		ART UNIT		PAPER NUMBER
				3626

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/655,667	BRIEGS ET AL.
	Examiner Natalie A. Pass	Art Unit 3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 08 September 2003 and 13 November 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-17, 19- 38, 43-45 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-17, 19- 38, 43-45 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### *Notice to Applicant*

1. This communication is in response to the amendments filed 8 September 2003 and 13 November 2003. Claims 1, 19, and 43 have been amended. Claims 18, 39-42 have been withdrawn. Claims 1-17, 19- 38, 43-45 remain pending.

### *Specification*

2. The objection to the abstract of the disclosure for undue length is withdrawn due to the amendments filed 8 September 2003 and 13 November 2003.

### *Claim Rejections - 35 USC § 112*

3. The rejection of claims 35-38 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is maintained. The rejection of claim 42 has been withdrawn, as that claim has been withdrawn, making the previous rejection moot.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 6-7, 11, 13, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colon et al., U.S. Patent Number 5, 991, 731 in view of DeBusk et al., U.S. Patent Number 5, 995, 937 for substantially the same reasons given in the previous Office Action (paper number 9). Further reasons appear hereinbelow.

(A) As per the amendments to claims 1 and 43, these appear to have been made merely to correct errors in the claim language, reciting the claims in a more positive manner. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 9, section 7, pages 5-9), incorporated herein.

The motivations for combining the respective teachings of Colon and DeBusk are as given in the rejection of claim 1 in the previous Office Action (paper number 9), and incorporated herein.

The remainder of claims 1 and 43 are rejected for the same reasons given in the prior Office Action (paper number 9, section 7, pages 5-9), and incorporated herein.

The motivations for combining the respective teachings of Colon and DeBusk are as given in the rejection of claim 1 in the previous Office Action (paper number 9), and incorporated herein.

(B) Claims 6-7, 11, 13 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 9, section 7, pages 6-7), and incorporated herein.

6. Claims 2-5, 15-17, 19, 20-22, 23-24, 28, 32-38, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colon et al., U.S. Patent Number 5, 991, 731 and DeBusk et al., U.S. Patent Number 5, 995, 937 as applied to claims 1, 19, and 43 and further in view of Edelson et al, U.S. Patent Number 5, 737, 539 for substantially the same reasons given in the previous Office Action (paper number 9). Further reasons appear hereinbelow.

(A) As per the amendments to claim 19, these appear to have been made merely to correct errors in the claim language, reciting the claims in a more positive manner. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 9, section 8, pages 9-11), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

The remainder of claim 19 is rejected for the same reasons given in the prior Office Action (paper number 9, section 8, pages 9-11), and incorporated herein.

The motivations for combining the respective teachings of Colon, DeBusk and Edelson are as given in the rejection of claims 1 and 19 in the previous Office Action (paper number 9), and incorporated herein.

(B) Claims 2-5, 15-17, 20-22, 23-24, 28, 32-38, 44 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 9, section 8, pages 9-16), and incorporated herein.

7. Claims 25-27, 29-30, 42, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colon et al., U.S. Patent Number 5, 991, 731, DeBusk et al., U.S. Patent Number 5, 995, 937 and Edelson et al, U.S. Patent Number 5, 737, 539, as applied to claim 19 above, and further in view of Umen et al, U.S. Patent Number 5, 734, 883 for substantially the same reasons given in the previous Office Action (paper number 9). Further reasons appear hereinbelow.

(A) Claims 25-27, 29-30, 42, 45 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 9, section 9, pages 16-19), and incorporated herein.

8. Claims 8-10, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colon et al., U.S. Patent Number 5, 991, 731 in view of DeBusk et al., U.S. Patent Number 5, 995, 937 as applied to claim 1 above, and further in view of Umen et al, U.S. Patent Number 5, 734, 883 for

(A) Claims 8-10, 12 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 9, section 10, pages 19-21), and incorporated herein.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colon et al., U.S. Patent Number 5, 991, 731 in view of DeBusk et al., U.S. Patent Number 5, 995, 937 as applied to claim 1 above, and further in view of Official Notice for substantially the same reasons given in the previous Office Action (paper number 9). Further reasons appear hereinbelow.

(A) Claim 14 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 9, section 11, pages 21-23), and incorporated herein.

10. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colon et al., U.S. Patent Number 5, 991, 731, DeBusk et al., U.S. Patent Number 5, 995, 937, Edelson et al., U.S. Patent Number 5, 737, 539, and Umen et al., U.S. Patent Number 5, 734, 883 as applied to claim 25 above and further in view of Official Notice for substantially the same reasons given in the previous Office Action (paper number 9). Further reasons appear hereinbelow.

(A) Claim 31 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 9, section 12, pages 23-24), and incorporated herein.

***Response to Arguments***

11. Applicant's arguments filed 8 September 2003 and 13 November 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the responses filed 19 June 2003 and 23 June 2003.

(A) At page 14 of the 13 November 2003 response, Applicant argues that the limitations of claim 1 are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Colon, DeBusk, Edelson, and Umen, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 9), and incorporated herein. In particular, Examiner notes that a main database of information concerning prior clinical trials and resources available to conduct future clinical trials the information concerning prior clinical trials being at least in part in the form of a protocol, the protocol of a prior clinical trial being stored in said main database, and the protocol of a prior clinical trial being stored in said main database in the form of a software template are taught by the cited references. In particular, please note (Colon; see at least Abstract, Figure 1, Item 12, column 1, line 35 to column 2, line 4, column 2, line 58 to column 3, line 22, column 3, lines 15-23, column 6, lines 1-14, lines 50-51, column 6, line 58 to column 7, line 31, column 7, lines 45-54), (DeBusk; column 6, lines 33-49, column 7, lines 40-59, column

8, lines 5-53, column 12, line 21 to column 13, line 34, column 14, line3 to column 15, line 30)  
as specifically applied in the rejections given above and incorporated herein.

(B) At pages 14-17 of the 13 November 2003 response, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's piecemeal arguments analysis of the references, it has been held that one cannot show nonobviousness by attacking references individually where, as here, the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(C) At page 14 of the 13 November 2003 response, Applicant argues that there is no suggestion to combine the references or that the motivation to combine the references is not the "present invention's purpose". In response to Applicant's argument, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti* et al 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In*

*re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In addition, the Examiner strongly advises that the claimed invention was considered "as a whole" and that every limitation recited in claims were specially addressed within the prior Office Action (paper number 9). Further, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art by expressly pointing to

specific portions of each applied reference and Examiner has expressly articulated the combinations and the motivations for combinations as well as the scientific and logical reasoning of one skilled in the art at the time of the invention that fairly suggest Applicant's claimed invention (see paper number 9).

In response to Applicant's argument on page 14 of the 13 November 2003 response that DeBusk fails to teach the standardization of a prior clinical trial being stored in a database in the form of a software template, the Examiner respectfully submits that the combination of the applied references teaches this limitation as detailed in the prior Office Action (paper number 9, section 7, pages 4-6). In particular, Examiner notes that Colon teaches a study management center storing clinical study data in a database in which the data is input into standardized forms (reads on protocols or templates), that the data are stored in the database tables which is additionally utilized for statistical analysis and automatic assignment of participants in clinical studies and trials and which "is controlled according to scientifically developed mathematical and statistical methods" and "consistent operation...across all activities" (reads on the standardization of a prior clinical trial being stored in a database) (Colon; Abstract, column 1, lines 47 to column 2, line 26, column 3, lines 14-22, column 4, lines 3-26, column 7, line 66 to column 8, line 1). Further, Examiner notes that the DeBusk reference teaches "software module objects ...[that]...are user created objects which represent individual templates..." that "allow for the development of custom software modules representative of the procedure for which information is to be managed" (reads on stored in a database in the form of a software template)

(DeBusk; column 6, lines 33-49, column 7, lines 40-59, column 8, lines 5-53, column 12, line 21 to column 13, line 34, column 14, line 3 to column 15, line 30).

In response to Applicant's argument on page 14 of the 13 November 2003 response that the applied references fail to teach wherein said main processor and main database are in an organizational environment which includes other databases with specialized information useful in formulating clinical trials, the Examiner respectfully submits that the combination of the applied references teaches this limitation as detailed in the prior Office Action (paper number 9, section 7, pages 6-7). In particular, Examiner notes that Colon teaches "a study management center ...at a particular geographical site...in which study data is maintained in a database in the host computer (11) behind a firewall provided in the Internet server computer" (reads on main processor and main database are in an organizational environment which includes other databases) and which includes "tables ... provided for each clinical study" and in which "[t]ables are joined as needed to produce regional and study-level management summaries and databases for statistical analysis" (reads on other databases with specialized information useful in formulating clinical trials ) (Colon; Figure 4, Items 47-53, column 2, line 58 to column 3, line 22, column 5, lines 5-45, column 6, lines 21-52, column 6, lines 60-66, column 7, lines 26-61).

In response to Applicant's argument on page 15 of the 13 November 2003 response that the applied references fail to teach wherein the other databases are one of a human resources database of personnel and location information, a finance database of budget authorization and cost information and a clinical supplies database of information on the availability of various

clinical medical products, the Examiner respectfully submits that the combination of the applied references teaches this limitation as detailed in the prior Office Action (paper number 9, section 7, page 7). In particular, Examiner notes that Debusk teaches databases of "supplies, kits (which are pre-packaged groups of supplies), equipment, personnel and pharmaceuticals" as well as "a database of listed [medical] supplies" and "databases of available [medical] supplies" (DeBusk; column 14, line 46 to column 15, line 13).

In response to Applicant's argument on page 15 of the 13 November 2003 response that the applied references fail to teach the input of information with regard to completion of tasks and tracking the completion of tasks in the protocol at a user processor, the Examiner respectfully submits that the combination of the applied references teaches this limitation as detailed in the prior Office Action (paper number 9, section 7, pages 7-8). In particular, Examiner notes that Debusk teaches "tracking resource utilization in individual patient cases ... [and] software allows the user to create case modules by selecting an already configured procedural pathway and adding patient and doctor specific information to it ... the user may then easily input information concerning the usage of the resources populating the clinical pathway and maintain a history of resource usage, costing information and/or clinical outcome ... provides for a historical database of resource utilization" (reads on the input of information with regard to completion of tasks and tracking the completion of tasks in the protocol at a user processor) (DeBusk; column 6, lines 33-49, column 7, lines 40-59, column 8, lines 5-61, column 12, line 21 to column 13, line 34, column 14, line 3 to column 15, line 56).

In response to Applicant's argument on page 15 of the 13 November 2003 response that the applied references fail to teach operating to synchronize the replicated and changed data at said main database and said subsidiary database, the Examiner respectfully submits that the combination of the applied references teaches this limitation as detailed in the prior Office Action (paper number 9, section 8, pages 11-13). In particular, Examiner notes that Edelson teaches data that is "preferably either synchronized or refreshed at intervals (e.g. overnight) from source databases" as well as teaching that "[e]ach data warehouse 212 maintains replicated copies of relevant data sets obtained by read-only access of remote databases 210, which data sets are maintained synchronously with updated source data at remote databases 210, or are periodically refreshed therefrom, preferably at frequent intervals" (emphasis added) (Edelson; column 7, lines 15-32, column 8, lines 4-10, column 46, lines 47-51, column 47, lines 8-20, column 48, lines 4-46).

In response to Applicant's argument on pages 15-16 of the 13 November 2003 response that the applied references fail to teach a site management module for indicating the conditions at the certain geographical location, information about the completion of tasks in the protocol at the certain geographical location are entered by the subsidiary user processor in the subsidiary database, and the site management module updates the information and locking and unlocking portions of databases, the Examiner respectfully submits that the combination of the applied references teaches these limitations as detailed in the prior Office Action (paper number 9, section 8, pages 11-13).

In response to Applicant's argument on pages 16-17 of the 13 November 2003 response that the applied references fail to teach a portion of data in the main database is replicated to said subsidiary database, a processor operative to display the clinical trial protocol, automatically indicating the completion of a major task when all of its minor related tasks are completed, the Examiner respectfully submits that the combination of the applied references teaches these limitations as detailed in the prior Office Action (paper number 9, section 9, pages 16-19). In particular, Examiner notes that Edelson teaches data that is "preferably either synchronized or refreshed at intervals (e.g. overnight) from source databases" as well as teaching that "[e]ach data warehouse 212 maintains replicated copies of relevant data sets obtained by read-only access of remote databases 210, which data sets are maintained synchronously with updated source data at remote databases 210, or are periodically refreshed therefrom, preferably at frequent intervals" (emphasis added)(reads on a portion of data in the main database is replicated to said subsidiary database ) and "system also provides, for example in the patient's history record, notification from a pharmacy, or from a drug benefit plan linked to the pharmacy, of fulfillment of a prescription" (reads on automatically indicating the completion of a major task when all of its minor related tasks are completed), (Edelson; column 7, lines 15-32, column 8, lines 4-10, column 27, lines 44-54, column 46, lines 47-51, column 47, lines 8-20, column 48, lines 4-46) and Umen teaches "displays a tabular list 66 of protocol and results details" (reads on display the clinical trial protocol) (Umen; see at least Figure 3, Items 56c, 66, Figure 6, Figure 7, column 10, lines 22-30).

At page 17 of the of the 13 November 2003 response, Applicant requests a reference or an affidavit to support the Official Notice taken in the prior Office Action of "sending a message to a provider of supplies to inform it of supplies needed".

In response, the Examiner hereby directs Applicant's attention to U.S. Patent No. 5,732,401 to Conway (cited herewith), which clearly evidences the use of sending a message to a provider of supplies to inform it of medical supplies needed as far back as 1996 three years prior to the filing of Applicant's present application (note especially column 11, lines 32-50 of Conway). As such, the knowledge and use of sending a message to a provider of supplies to inform it of medical supplies needed, has clearly existed in the art prior to Applicant's claimed invention and the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention.

*In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

(D) At page 14 of the 8 September 2003 response, Applicant argues the rejection under 35 U.S.C. 112, second paragraph of claims 35 and 36. In response to Applicant's argument, the Examiner notes that it is not clear what distances or geographical boundaries are required for the processors and the databases to be in the same or different geographical areas. As discussed in the personal interview, a "geographical area" can exist around a cubicle, around a room, around a building, around a subdivision, around a city block, around a city, around a country, etc. As such, claims 35 and 36 do not meet the requirement that claim limitations are "precise, clear, correct, and unambiguous" (MPEP §§ 2171 - 2174).

(E) At pages 15-17 of the 8 September 2003 response, Applicant argues that the limitations of the invention are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Colon, DeBusk, Edelson, and Umen, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 9), and in the discussion above, and incorporated herein.

(F) At pages 15-17 of the 8 September 2003 response, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's piecemeal arguments analysis of the references, it has been held that one cannot show nonobviousness by attacking references individually where, as here, the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. **Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks  
Washington D.C. 20231

**or faxed to:**

(703) 305-7687.

For formal communications, please mark  
"EXPEDITED PROCEDURE".

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

NP

Natalie A. Pass

January 29, 2004

Alexander S. Kacynski  
Alexander Kacynski  
Primary Examiner  
APR 3626